

## REMARKS

After entering the instant amendment, claims 1-3 and 5-34 are pending in the present application, claim 4 having been previously cancelled and claims 31 34 having been cancelled herein (the subject matter of claim 31 has been incorporated into claim 1). Claims 1 and 2 have been amended. It is respectfully submitted that the instant application is now in condition for allowance inasmuch as the claims are now directed to compositions comprising three separate and visually distinct layers which separate within 24 hours after mixing. Support for the amendments to the claims can be found throughout the original specification and claims. No new matter has been added by way of the present amendment.

The Examiner has rejected the previously pending claims variously under 35 U.S.C. §102 and 103 for the reasons which are presented in the office action dated February 22, 2006. Applicants respectfully traverse the Examiner's rejections for the reasons which are presented in the sections which follow. It is respectfully submitted, that with the amendment to the claims, there is no way to conclude that the presently claimed invention is anticipated or rendered obvious by the art cited by the Examiner.

### The §102 Rejections

The Examiner has rejected previously filed claims 1-2, 5-6, 8-21, 24-26 and 28-29 under 35 U.S.C. §as being anticipated by U.S. patent no. 6,043,204 ("Kaufman"). The Examiner cites Kaufman for teaching the use of a high density aromatic ester octyl methoxy cinnamate (column 4, line 64), as well as octyl salicylate which may also be a high density aromatic ester (column 6, lines 5-45), relevant surfactants (column 6, lines 5-45), exfoliating agents (column 8, line 35 for lactic and glycolic acid), penetration enhancers (column 8, lines 32-33 for propylene glycol, butylene glycol and glycerin) and the claimed low-density oil (column 7, lines 45-67). The Examiner posits that the composition of Table 2, example 12 of Kaufman anticipates the present invention. Applicants respectfully traverse the Examiner's rejection.

The present invention, as described above, is referenced here. It is a composition which comprises *at least three visually distinct and separate liquid layers*. There is absolutely no evidence in Kaufman that Kaufman provides a disclosure which produces the presently claimed invention. Contrary to the Examiner's contention, the composition of table 2, example 12 does not give rise to the present invention because that composition is a completely mixed product which does not separate upon settling, nor is it intended to separate after mixing. That example of the prior art is a composition which is a homogeneous emulsion (and is designed to be a homogenous emulsion), completely unlike the present invention and has only a single visual layer in the form of an emulsion (which itself has more than one phase, but *appears as a single visual layer* in contrast to the presently claimed invention). That is clear from the text of the reference that a single visual layer is intended, because there is absolutely no reason to *intentionally provide* a multi-layer product as in the present invention. In Kaufman, there is *absolutely no discussion* of the disclosed composition separating into *three distinct* layers as in the present invention.

Note that Kaufman is directed generally to body cleansing compositions which provide protection against sunburn after rinsing of the user's body. Thus, in the first instance, through the very use of the Kaufman composition, there is absolutely no motivation to make a composition which comprises three layers- i.e., three layers is *counterintuitive* to the general teachings of Kaufman. In addition, in Kaufman, there is absolutely no discussion or suggestion of providing a composition with *three distinct visual layers* as in the present invention. *Anywhere.*

From the limited disclosure in Kaufman, the Examiner has opined that Example 12 *inherently* produces the present invention. Applicants have argued that there is absolutely no basis upon which the Examiner can conclude that Kaufman teaches the present invention not the least of which such an inherent teaching would be completely *contradictory* to the general teachings of Kaufman and if it occurred (for example, accidentally) this would be perceived as an unworking example of Kaufman's teachings. Note that the example mentions that the composition is *homogenized*. There is absolutely no teaching to suggest that composition separates into three visually distinct layers and there is no basis to conclude that it would because

in conventional terms such a result would be *undesirable*. Note that there is no teaching or suggestion *anywhere* in Kaufman which teaches or motivates the person of ordinary skill to provide a composition comprising three distinct visual layers which are produced in the composition after a thorough mixing of the product. That is because such a result is *counterintuitive to the teachings of Kaufman* and is the reason the present invention is patentable. Note also that there is no mention or suggestion of specific gravity or density, important features of the present invention.

It is respectfully submitted that the Examiner, *without any evidence to which she can point or articulate, and in light of the clearly deficient disclosure of Kaufman which has nothing to do with the present invention and teachings away from the present invention*, has engaged in an *impermissible hindsight construction* and argues *without any basis*, that the teachings of Example 12 of Kaufman anticipate the present invention. The Examiner has now placed the burden of reproducing Example 12 of Kaufman, *without any basis whatsoever*, on Applicant in order to seek allowance. Applicants respectfully submit that this approach not only inappropriate, it is also unfair.

Nor does the prior art represent an inherent anticipation. There is absolutely no evidence in example 12 that in order to use the product one mixes the visually separate layers- precisely because there is no need to mix the homogenized product. That omission of a mixing step prior to use of the composition of example 12 evidences that the composition of Kaufman *is not* a multilayered composition according to the present invention and doesn't separate into a multilayered composition as in the present invention. There is simply no credible way that the composition of example 12 may be construed to be directed to a composition according to the present invention which settles into at least three visually distinct layers after mixing and consequently, Kaufman cannot be read to anticipate the present invention.

As the Court said in *Continental Can Co. USA, Inc. v. Monsanto Co.*, 20 USPQ2d 1746, 948 F.2d 1264 (Fed. Cir. 1991):

To serve as an anticipation when the reference is silent about the asserted inherent characteristics, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence *must make clear* that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. [Emphasis added].

*In re Oelrich*, 212 USPQ 323, 326, 666 F.2d 578, 581 (CCPA 1981) (quoting *Hansrig v. Kemmer*, 40 USPQ 665, 667, 102 F.2d 212, 214 (CCPA 1939) provides:

Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performed of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Here, the Examiner has not made out even an arguable case that example 12 will produce inherent results which will meet the limitations of the claim. Rather, *all evidence from Kaufman* points to example 12 *not* inherently producing the claimed invention, not even *accidentally*. It is respectfully submitted that the example 12 does not produce and cannot produce results which would anticipate the present invention and it is clear that there is no anticipation here. As the Court said in *In re Newell*, 13 USPQ2d 1248, 891 F.2d 899 (Fed. Cir. 1989), *Cert. Denied* 493 US 814 (1989), "A retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination."

It is respectfully submitted that here, the Examiner is misapplying an inherency analysis in a retrospective manner without reference to *any* support in Kaufman which suggests that example 12 would produce an inherent outcome or result, even *accidentally*. For example 12 to produce the presently claimed result accidentally would be for example 12 to completely deviate from and negate the teachings of Kaufman which gave rise to example 12 in the first place. As such, the Examiner's arguments must fail and Applicants respectfully request the Examiner to withdraw the rejection based upon Kaufman.

#### The §103 Rejection

The Examiner has also rejected previously filed claims 1-3, 5-21 and 24-30 as being unpatentable over a combination of US 2002/20160023 of Bagdi, et al. ("Bagdi") and Kaufman.

The Examiner cites Bagdi (same as PG PUB '023) as teaching multiphase formulations (see examples 1 and 2 for three and four phase formulations). The Examiner cites Bagdi further for teaching penetration enhancers, oils and exfoliating agents. The Examiner contends that Bagdi suggests the incorporation of sunscreens (the high density esters of the present invention). The Examiner cites Kaufman for teaching surfactants for use in body cleansing compositions along with other claimed ingredients.

Accordingly, the Examiner argues that it would have been obvious to one of ordinary skill in the art at the time of the present invention to prepare multiphase compositions of Bagdi and add the claimed sunscreens and surfactants of Kaufman for their beneficial effect on the skin. The motivation stems from the scientific knowledge that surfactants are used mostly in cleansing compositions and the motivation to add the sunscreen to the composition to provide protection from the sun. This, the Examiner contends, makes out a *prima facie* case of obviousness. Applicants respectfully traverse the Examiner's rejection.

The present invention relates to personal care cleansing products which are multiphasic and which produce *at least three visually distinct liquid layers* upon settling within 24 hours after mixing. The disclosures of Bagdi and Kaufman in combination in no way render the present invention obvious. Moreover, it is respectfully submitted that the Examiner has not made out a cogent case that the present invention is *prima facie* obvious over a combination of Bagdi and Kaufman because a combination of the cited disclosures would not produce a composition with at least three visually distinct layers which appear upon settling within 24 hours of mixing which is a critical feature of the present invention. Rather, such a combination would produce a multiphasic composition as a homogenized emulsion which appears as a single visual layer. This is **not** the present invention. There is no *suggestion* of the present invention. Further, there is absolutely no motivation from the teachings of the prior art references to produce the present invention.

The present invention relates to personal cleansing compositions such as body cleansers and shampoos, for example, which are multiple phase surfactant compositions comprising at least three visually distinct and separate liquid layers which appear upon settling after mixing,

wherein the compositions comprise a first or lower high density layer consisting essentially of at least one high density aromatic ester (as defined in the specification on page 7 as a high density aromatic ester emollient/conditioning agent) having a specific gravity of greater than 1.00, a second or middle layer consisting essentially of a surfactant solution having a specific gravity of less than the specific gravity of said high density first layer, and a third or upper layer consisting essentially of a low density oily material having emollient or conditioning characteristics and a specific gravity which is less than said first layer and said second layer, wherein said three visually distinct and separate liquid layers appear upon settling within 24 hours after mixing said composition. The present invention is directed to compositions which exhibit activity as surfactant compositions having emollient characteristics and a pleasant three-layered liquid presentation. The compositions are particularly adapted as personal care cleansing compositions having both cosmetic characteristics and favorable presentation. Thus, the present invention relates to personal care compositions which exhibit excellent surfactant and emollient/conditioning characteristics with a superior presentation, that presentation being the separation of the product into at least visually three distinct liquid layers.

Bagdi does not disclose or suggest the present invention. Bagdi, as perhaps hundreds/thousands of patents and other references in the cosmetic field, discloses the preparation of formulations by first preparing a composition in separate phases (actually, simple mixtures) and then mixes the phases together to form a final formulation or composition having a single layered presentation. Bagdi does not disclose or suggest that the phases should separate or that it is desirable to have them separate into at least two visually distinct liquid layers upon settling after mixing the final formulation. Indeed, such a proposition, is actually counterintuitive from the disclosure of Bagdi. Without any suggestion to provide a composition which actually separates into three distinct layers upon settling after mixing, Bagdi does nothing to render the present invention obvious. There is therefore, no motivation from Bagdi to make the present invention. Bagdi's discussion of two phases refers to a typical emulsion, which, by definition, does not present itself as having two visually distinct layers, as is the case with the present invention, but rather a single visual layer in order to promote consistency of formulation. Bagdi cannot reasonably be read to teach compositions according to the present invention which produce two visually distinct layers after settling and there is absolutely no mention or

motivation to produce such a composition. Moreover, Bagdi does not even mention or suggest the specific gravity or the density of any components or layers of the composition, critical features of the present invention. Moreover, the compositions of Bagdi are *gelled*, wherein the compositions are locked into their physicochemical character. The compositions of Bagdi do not and are not meant to separate into distinct visually separate layers. In that sense Bagdi actually *teaches away* from the present invention.

Kaufman, for reasons which have been previously stated, is not directed to compositions according to the present invention. For the reasons previously discussed, Kaufman does not make out an anticipatory rejection and cannot possibly *inherently* anticipate the present invention. The example the Examiner points to, example 12, does not separate into three visually distinct layers and is not taught to separate into three visually distinct layers. There is absolutely no evidence in Kaufman that the compositions disclosed therein are thoroughly mixed and then allowed to separate after mixing- because such an approach would be seen as compromising the compositions taught therein. Because there is no discussion of mixing of the formulation just prior to use- it is clear that Kaufman has presented a single visual layered composition. A typical storage stable cosmetic composition presents itself as a single layered composition as visually presented, even if it is a bi-phasic or multi-phasic *emulsion*. That is the gist of the distinction between the prior art and the present invention. Whereas, the prior art teaches an emulsion (which can contain more than than one phase) which is presented as a single visual layer in order to promote consistency, the present invention cuts completely against this common convention and provides a cosmetic composition having at least three visually distinct layers which appear within 24 hours after a mixing step which makes the present invention, due to the mixing, into a short-lived single layered composition.

Kaufman cannot be seen as teaching or suggesting the present invention when the teachings of Kaufman and conventional formulations are single layered compositions. Indeed, a three-layered composition is not even mentioned by Kaufman and would otherwise be inconsistent with the teachings of Kaufman because it would bring to mind instability and formulation inconsistency, *an undesirable trait*. Moreover, there is absolutely no disclosure in Kaufman which would motivate one of ordinary skill to produce the present compositions-

indeed the concept that gives rise to the present invention- that of allowing three visually distinct layers to form upon settling after mixing- is actually *contrary* to the teachings of Kaufman. Moreover, Kaufman does not even mention specific gravity or density *at all*, whereas different specific gravities of layers are a *sine qua non* for producing the present invention.

Without a rationale which recognizes that the separation of a composition into visually distinct layers is actually cosmetically *favorable* (as opposed to a negative characteristic generally recognized by those in the art as representative of *instability* and therefore merely accidental, if it even ever exists), there can be no motivation in the combination of Kaufman and Bagdi to produce the present invention. Formulation chemists actually work overtime to *avoid the formation of distinct visual layers evidencing* separation as in the present invention. The idea is to maintain the integrity of the emulsion, i.e., to provide a stable, single visual layer throughout the composition which contains more than one phase. The same is true for the teachings of Kaufman and Bagdi. Without the express teaching of the present invention, the prior art cannot be read as creating the present invention, especially when the present invention, when read in context with the prior art teachings is viewed as being extremely *unfavorable* (i.e., unstable and undesirable) to the concepts and teachings of the art. Thus, the teachings of the art are unlike the present invention which actively encourages/produces phase separation because it is viewed as being desirable cosmetically and a necessary feature of the present invention. Because there is no motivation to create the present invention, there is nothing in the combined disclosure of Kaufman and Bagdi which would result in the production of the present invention which is directed to compositions which form three visually distinct liquid layers upon settling within 24 hours after mixing.

Note that in the examples in Bagdi and Kaufman, the final products which are produced are *uniform emulsions*, and in the particular case of Bagdi, the homogenous compositions are *gelled*- precisely to lock in the emulsion in a single visual layer and avoid any separation into layers- a critical feature of the present invention. Thus, the combined teachings of Kaufman and Bagdi actually *teach away* from the present invention precisely at the point of invention (the multiphase visually layered nature of the final composition) and cannot be cogently used to render the present invention obvious. Without some motivation or teaching (which is absent



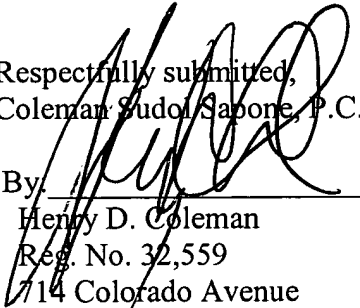
from Kaufman and Bagdi), the person of ordinary skill would provide a uniform, homogenous composition and would actually *avoid* the present invention.

For all of the above reasons, it is respectfully submitted that the present application is now in condition for allowance and such action is earnestly solicited. Two dependent claims have been cancelled. No fee is due for the presentation of this amendment. A petition for a one month extension of time is enclosed and the accompanying fee. If the Examiner decides that any further fee is required or credit is due, the Commissioner is authorized to charge any such fee or credit any such overpayment to deposit account 04-0838.

An indication of any charge made to the authorized Deposit Account is respectfully requested at the time of the issuance of a further office action, so that the charge may be accurately tracked for accounting purposes.

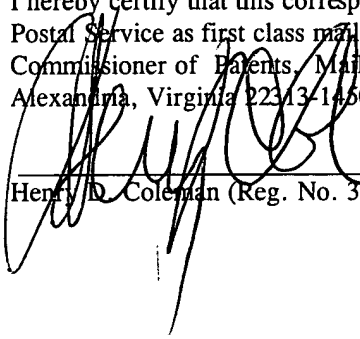
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